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| EXAMINER KLINKEL, KORTNEY L. | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/511,046

Applicant(s)

DANIELSEN ET AL.

Examiner

Kortney L. Kinkel

Art Unit

1611

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-12 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)
- Paper No(s)/Mail Date 1/17/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

Receipt is acknowledged of remarks filed January 17, 2008.

Claims 4 and 10 were amended.

Claims 16-18 were added.

Claims 1-14 and 16-18 are pending in the instant Office Action.

All rejections/objections not addressed herein have been withdrawn.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on January 17, 2008 is acknowledged. The serial number listed for the Svendsen et al. PGPub was in error. The Examiner has corrected the citation. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

Response to Arguments

Rejection of claims 1-12 under 35 USC § 103 over Johansen et al. (US 6100080)

Applicant's arguments, see page 4-5, filed January 17, 2008, with respect to the rejection of claims 1-12 under 35 USC § 103(a) as being unpatentable over Johansen et al. (US 6100080) have been fully considered and are persuasive in part.

The rejection of method claims 4-12 is *withdrawn* in light of Applicant's arguments. Johansen does not teach the active step of contacting spores with the composition.

The rejection of claims 1-3 under 35 USC § 103(a) as being unpatentable over Johansen et al. (US 6100080) is *maintained* for reasons of record, the portion of the rejection relevant to the composition has been restated below.

Newly added claims 16-18 are rejected as being drawn to the same subject matter as instant claims 1-3 and are therefore rejected under the same statute and reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen (US 6,100,080).

The claims recite a composition comprising a laccase or a compound exhibiting laccase activity, a source of oxygen, an enhancing agent and a source of iodide ions, wherein the source of iodide ions is one or more salts of iodide and which can further comprises a surfactant.

Johansen teaches a biocidal composition comprising laccase, the atmosphere as a source of oxygen, and a surfactant (col. 7, lines 12-26; col. 11, lines 58-59). Johansen also teaches the use of this composition on a textile surface and a surface present in a process equipment member of a cooling tower, a water treatment plant, a dairy, a food processing plant, a chemical or pharmaceutical process plant (col. 2, lines 34-39).

The disclosure of Johansen does not specifically discuss the use of the composition as a sporacide or the use of enhancing agents and iodide salts in combination with laccase.

However, Johansen teaches a method of using the composition for treatment of biofilm (col. 7, lines 12-26; col. 8, lines 22-29; col. 11, lines 58-59) and that enhancing agents and iodide salts as a source of ionic iodide can be used as electron-donors in combination with peroxidase (col. 8, lines 22-29).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to use an enhancing agent and iodide salt as an electron-donor in

combination with laccase because laccase also catalyzes an oxidation/reduction reaction.

Response to arguments. Applicants' arguments filed January 17, 2008 with respect to composition claims 1-3 and 16-18 have been fully considered but are not persuasive.

Applicants argue that Johansen does not recognize the use of the composition as a sporicide and therefore not all the limitations of the claims have been taught. In response to applicant's arguments, the recitation "a sporicidal composition" in claims 1-3 and 16-18 has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As it stands, the composition taught by Johansen is capable of performing the intended use of claims 1-3 and 16-18, namely that as a sporicide. Claims 1-3 and 16-18 do not have any limitations which structurally differentiate themselves from the teachings of the prior art.

Claim 16 recites "wherein the mixture is present in an amount effective for killing or inactivating spores". Without a more precise definition as to what an effective amount for killing or inactivating spores actually is in order to impart a structural difference between the claimed invention and the prior art, Johansen teaches the limitations of claims 16-18.

Rejection of claims 13-14 under 35 USC § 103 over Johansen et al. (US 6100080) in view of Svendsen et al. (US 6221821)

Applicant's arguments, see page 5, filed January 17, 2008, with respect to the rejection of claims 13-14 under 35 USC § 103(a) as being unpatentable over Johansen et al. (US 6100080) and in further view of Svendsen et al. (US 6221821) have been fully considered but they are not persuasive.

The rejection of claims 13-14 under 35 USC § 103(a) as being unpatentable over Johansen et al. (US 6100080) and in further view of Svendsen et al. (US 6221821) is *maintained* for reasons of record, and restated below.

Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansen (US 6,100,080) as applied to claims 1-12 above, and further in view of Svendsen, et al. (US 6,221,821).

Claims 13-14 recite the composition of claim 1, wherein the components of the composition are packaged in one or more compartments or layers or in a ready-to-use sporocidal formulation.

Although Johansen teaches the composition of claim 1, the disclosure does not teach that the composition can be packaged in one or more compartments or layers or in a ready-to-use sporacidal formulation.

Svendsen, et al. teach that an anti-microbial composition can be used in a two part formulation system, wherein one component is separated from the rest. Svendsen, et al. also teach that such a composition can be a ready-to-use product (col. 9, lines 64-67; col. 11, lines 16-26).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to package a sporacidal composition in a container that separated the components so that they would not mix before use. It would have also been obvious to a person of ordinary skill in the art at the time the invention was made to package a sporacidal composition in a ready-to-use formulation so that using the sporacide would be more convenient.

Because claims 13 and 14 depend upon claim 1, and claim 1 is obvious over the teachings of Johansen as discussed above, rejection of claims 13 and 14 under 35 USC § 103(a) as being unpatentable over Johansen et al. (US 6100080) and in further view of Svendsen et al. (US 6221821) is appropriate.

Allowable Subject Matter

Claims 4-12 are allowable over the prior art.

Conclusion

Claims 1-3 and 16-18 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kortney Klinkel, Ph.D. whose telephone number is (571)270-5239. The examiner can normally be reached on Monday-Friday 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached at (571)272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KLK

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615